

REMARKS

Applicant submits these Remarks in reply to the Office Action mailed April 28, 2009 ("Office Action"). Claims 1-30 are pending in this application, of which claims 1, 11, and 21 are independent.

In the Office Action, the Examiner took the following actions:

- (1) rejected claims 1-10 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; and
- (2) rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over *Strozniak*.¹

Applicant respectfully traverses these rejections as follows.

I. 35 U.S.C. § 101

The Office rejected claims 1-10 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicant maintains that the claims as filed recite statutory subject matter, Applicant has amended independent claim 1 in order to place this application in condition for allowance. Specifically, the method of claim 1 now positively recites implementation of the method on a computer having a processor, thus identifying the apparatus that accomplishes the method steps. No new matter has been added. Therefore, as amended, the specific method steps of claim 1 are tied to a statutory class and cannot be performed without the use of a particular apparatus.

¹ Applicant notes the Office Action indicates that only claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30 were rejected under 35 U.S.C. § 103(a). Office Action at 4. However, the Examiner's analysis treated claims 1-30 as being rejected under 35 U.S.C. § 103(a). Office Action at 4-8. Accordingly, this Response assumes that the Examiner intended to reject claims 1-30 under 35 U.S.C. § 103(a).

Consequently, Applicant submits that this claim, as amended, conforms with the recent Federal Circuit decision in *In re Bilski*, ___ F.3d ___, 2008 WL 4757110 (Fed. Cir. Oct. 29, 2008) (*en banc*). Claims 2-10 depend from claim 1 and by virtue of their dependence upon claim 1 and for the reasons set forth above, are also tied to a statutory class. Therefore, Applicant respectfully requests the withdrawal of the Section 101 rejection of claims 1-10.

II. 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner's rejections of claims 1-30 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole*

would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A. The reference does not teach "analyzing past load history based on dedicated and common carrier rates"

The cited reference, either alone or in combination with the Office's Official Notice, does not teach or suggest "analyzing past load history based on dedicated and common carrier rates," as recited in Applicant's independent claims 1, 12, and 21. In rejecting claims 1, 12, and 21, the Office asserts that "[s]ince *Strozniak* teaches determining costs savings of combining or sharing routes, there must be some analysis of past data to determine a comparison for future routes. While *Strozniak* is silent as to whether the analysis of routes uses historical data, [the] Examiner asserts that it is old and well known in the art of route planning to analyze previous or historical data as a way to forecast better alternative route plans." Office Action at 4. Applicant respectfully disagrees with this reading of *Strozniak*.

Fundamentally, the basic premise of *Strozniak* is that companies, with the aid of technology, can collaborate and share shipping options to reduce overall costs for all

participants. *Strozniak* p. 1, ¶ 1 ("Companies now use technology to collaborate, which - if done properly - means sharing critical information and working to achieve mutual benefits"); *id.* p. 2, ¶ 1 ("On continuous-move tours companies can see a logistics savings that ranges between 5% to 25%, but the average savings is about 15%"). Indeed, the participants decision to collaborate and share truck capacity appears to be based solely on the upcoming delivery needs of each party. *Strozniak* p. 5, ¶ 4 ("When a company joins the network . . . Nivesto identifies potential partners by comparing transportation routes of other members. This comparative analysis scores and ranks which companies would benefit from collaborating on common lanes."). Thus, contrary to the Office's assertion, there need not "be some analysis of past data to determine a comparison for future routes." The only comparison contemplated by *Strozniak* is the future cost of using a share route versus the future cost of not using a shared route.

The Office takes Official Notice that "it is old and well known in the art of route planning to analyze previous or historical data as a way to forecast better alternative route plans." Office Action at 4. M.P.E.P. § 2144.03 instructs that relying upon "common knowledge" should only be applied in rare instances. Even if true and evidence can be supplied to support such a conclusory statement, citing to this fact does not cure the defects noted above in *Strozniak*.

As noted above, *Strozniak* focuses on how manufacturers can collaborate and reduce costs by sharing space on dedicated carriers. In such a situation, there would be no benefit to analyzing past load history as the only relevant consideration is the cost of the proposed route sharing option. Thus, because there is no benefit to considering

historical data in *Strozniak*, there would be no reason or motivation to analyze “past load history based on dedicated and common carrier rates” as claimed.

Similarly, *Strozniak* does not teach or suggest “analyzing past load history based on dedicated *and common carrier rates*,” as recited in claims 1, 11, and 21 (emphasis added). The premise of *Strozniak* is how companies can collaborate and share their dedicated carriers to reduce costs. See, e.g., *Strozniak* p. 2, ¶ 1 (“Manufacturers and trucking companies are . . . reducing costs by sharing truck capacity and warehouse operations, and consolidating small shipments from several companies onto one truck.”); *id.* p.4, ¶ 3 (the Nivesto network creates “round-trip or dedicated tours between manufacturers. In other words, carriers would be guaranteed a truckload on their return trips, which reduces the costs for manufacturers because the trucks are not returning empty.”); *id.* at p. 4, ¶ 4 - p. 5, ¶ 1. These example are limited only to dedicated tours.

The Office's reliance on the General Mills - Georgia Pacific example is similarly misplaced as that passage indicates that only dedicated rates were considered. (“General Mills and Atlanta-based Georgia-Pacific . . . formed a 1,800 mile tour . . . Georgia-Pacific used the same truck to transport its products on the return trip.”). Had common carrier rates been considered, General Mills may have elected to send its shipment via common carrier instead of scheduling a tour with Georgia-Pacific products. Accordingly, the Office has not clearly articulated a reason why one of ordinary skill in the art would modify *Strozniak* to achieve the claimed invention or would find the invention obvious in view of *Strozniak*.

Moreover, the disclosure of *Strozniak* itself prevents modification of its teachings to reach the subject matter of claims 1, 11, and 21. Specifically, and as previously

noted, the disclosure example in *Strozniak* relied upon by the Examiner actually teaches away from "analyzing past load history based on dedicated and common carrier rates."

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02(vi) 8th Ed., Rev. 6 (Sept. 2007) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P. Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). "A reference may be said to teach away . . . if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999).

Strozniak teaches a system of "reducing costs by sharing truck capacity and warehouse operations, and consolidating small shipments from several companies onto one truck." *Strozniak* p. 2, ¶ 1. Thus, the essence of this approach is that shipping efficiencies can be improved by combining shipments from at least two companies onto one truck. Necessarily, common carrier rates are not analyzed as they would only benefit one company, and cuts against the level of "collaboration" contemplated by *Strozniak*. In other words, the addition of common carriers to the *Strozniak* analysis would necessarily undermine the stated goal of collaboration between companies. If the companies described in *Strozniak* began using common carriers, the system would break down as there would be fewer partners with whom companies could collaborate and share shipping costs. Indeed *Strozniak* lists the lack of vendors and the participants reluctance to share information as the primary drawbacks of collaborative logistics. *Strozniak* p. 3, ¶¶ 1-3. The introduction of common carrier options would only

exacerbate these problems. By focusing on how to improve the efficiencies of multiple companies, *Strozniak* must avoid solutions which would benefit a single company to the possible detriment of another. Thus, because *Strozniak* teaches away from the claimed invention, the Examiner has not clearly articulated a reason why the claimed invention would have been obvious.

B. The reference does not teach “automatically creating the tour schematic based on analysis of the past load history.”

Independent claims 1, 11, and 21 also recite, among other things, “automatically creating the tour schematic based on analysis of the past load history.” *Strozniak*, either alone or in combination with Official Notice, does not disclose, teach, or suggest this subject matter. In rejecting claims 1, 11, and 21, the Office points to page 4, paragraph 3 of *Strozniak* which states in full:

To address the problem the manufacturer’s alliance used the Nivesto network to match routes that essentially would create round-trip or dedicated tours between manufacturers. In other words, carriers would be guaranteed a truckload on their return trips, which reduces the cost for manufacturers because the trucks are not returning empty. This allows a carrier to provide a rate reduction to both manufacturers. Additionally, it increases the profit margins of carriers because of better asset utilization. What’s more, it helps reduce turnover of drivers who no longer have to scramble to fill their trucks on the return trip. At the same time, service improves because drivers become familiar with the routes and develop business relationship with both the shippers and their customers.

Contrary to the Examiner’s assertions, nothing in this passage discloses, teaches or suggests that the *Strozniak* system automatically creates a tour schematic or that it creates a tour history based upon past load history. In fact, the only references to automation are found elsewhere in the reference. *Strozniak* p. 7, ¶ 2 (“Collaborative-logistics service Elogex uses its technology to automate the entire collaborative

process, while not requiring any internal changes by participating companies."); *id.*, p. 7, ¶ 4 - p. 8, ¶ 1. ("[Elogex] automates all of the logistics details based on a company's rules, parameters, requirements, and contract agreements with carriers."). However, these excerpts are directed to automating the collaboration process between shipping entities, and fail to disclose, teach or suggest "automatically creating the tour schematic based on analysis of the past load history."

As described above, the Office's use of Official Notice is insufficient to cure this defect as there would be no reason to use past load history in the system discussed in *Strozniak*. Thus, the recitation from independent claims 1, 11, and 21 of "automatically creating the tour schematic based on analysis of the past load history".is not taught, disclosed, or suggested by *Strozniak*, either alone or in combination with the Office's taking of Official Notice.

C. No *prima facie* case of obviousness

For the above reasons, the Office Action fails to clearly articulate a reason why *Strozniak*, either alone, or in combination with Official Notice, would have rendered the claimed invention obvious to one of ordinary skill in the art. Consequently, a *prima facie* case of obviousness has not been established.

Because no *prima facie* case exists, Applicant respectfully requests that the Office withdraw the rejection of amended independent claim 1, and independent claims 11, and 21. Because dependent claims 2-10, 12-20, and 22-30 necessarily contain the recitations of one of the independent claims, Applicant also requests withdrawal of the rejections of the dependent claims for the same reasons, and allow pending claims 1-30 as amended.

III. Conclusion

The preceding remarks are based solely on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

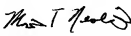
In view of the foregoing remarks, Applicant submits that this claimed invention is not rendered obvious in view of the prior art reference cited against this application. Applicant therefore requests the entry of this reply, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. Finally, Applicant submits that the entry of this response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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